

REMARKS

In response to the Office Action mailed November 4, 2009 ("the Office Action"), Applicant respectfully requests reconsideration and reexamination of this application, removal of the rejections outlined below, and the timely allowance of the pending claims.

Status of the Claims

Claims 13-22 are pending in the application. Claims 1-12 were cancelled previously. By this amendment, Applicant amends claim 13. Accordingly, claims 13-22 remain for examination.

Rejection of Claim 13 Under 35 U.S.C. § 112

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, for allegedly lacking sufficient antecedent basis for the phrase "the positions." Office Action at p. 2. Claim 13 is amended above, removing the phrase "the positions." Accordingly, applicant respectfully submits that the rejection under section 112, second paragraph, is now moot.

Rejection of Claims 13 and 15-18 Under 35 U.S.C. § 102(b)

Claims 13 and 15-18 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,402,750 to Atkinson et al. ("Atkinson"). Office Action at p. 2. Applicants traverse the section 102(b) rejection of claims 13 and 15-18, and respectfully request withdrawal of the rejection for at least the following reasons.

To anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); see MPEP 2131. In the present application, claim 13, as amended, recites the following (emphasis added):

13. A distraction and damping device, comprising:
- a first rod member having a first end;
 - a second rod member having a second end;
 - a mechanical coupler connecting the first rod member to the second rod member and allowing adjustment of a distance between the first end of the first rod member and the second end of the second rod member to straighten the spine of a patient; and
 - a first damping member, having a first end coupled to the first end of the first rod member and a second end configured to be coupled to a first bone structure,
- wherein the first rod member can pivot within the first damping member to adjust the alignment of the first rod member with respect to a longitudinal axis of the first damping member.

Nowhere does Atkinson disclose a device in which a "first rod member can pivot within [a] first damping member to adjust the alignment of the first rod member with respect to a longitudinal axis of the first damping member[" and thus, Atkinson cannot anticipate claim 13.

The Office Action alleges that Atkinson discloses "a first rod member (112) having a first end (FIG 10C; end of 112 in contact with 113)[]" and "a first damping member (111), having a first end coupled to the first end of the first rod member (112; FIG 10C)[.]" Notwithstanding, Atkinson does not disclose that piston 112 can "pivot within" barrel 111 "to adjust the alignment of the first rod member with respect to a

longitudinal axis of" barrel 111. Atkinson only discloses that piston 112 may be longitudinally displaced relative to barrel 111. Atkinson at col. 16, ll. 12-14. Further, as clearly illustrated in Fig. 10C of Atkinson (reproduced here for reference), piston 112 cannot "pivot within" barrel 111 "to adjust the alignment of [piston 112] with respect to a longitudinal axis of" barrel 111, because the rigid collar 116 and barrel 111 prevent such motion. Accordingly, as Atkinson fails to disclose a device in which a "first rod member can pivot within [a] first damping member to adjust the alignment of the first rod member with respect to a longitudinal axis of the first damping member[,]"

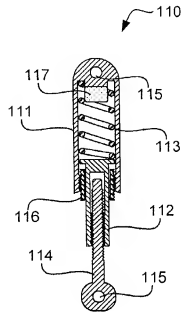


FIG. 10C

Atkinson cannot anticipate claim 13. Furthermore, claims 15-18 depend from claim 13, and thus, are not anticipated by Atkinson for at least the same reasons. Finally, claims 13 and 15-18 are not obvious over Atkinson for at least the same reasons.

Rejection of Claims 13-22 Under 35 U.S.C. § 103(a)

Claims 13-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WIPO Publication 2000/72768 A1 to Fortin ("Fortin")¹ in view of U.S. Patent 5,375,823 to Navas ("Navas"). Office Action at p. 3. The Examiner contends

¹ Throughout this Response, in reference to the content of French language WIPO Publication 2000/72768 A1, Applicant will cite to U.S. Patent 7,029,472 to Fortin, which was filed as the national stage entry of the international application associated with WIPO Publication 2000/72768 A1, and which Applicant believes to be an accurate English translation thereof.

that Fortin discloses each of the elements of the claims except "first and second dampening members coupled to the first and second ends (38,39) of the first and second rod members (35,36)." *Id.* at p. 4. The Examiner further alleges that Navas teaches a device disclosing the remaining claimed elements and that it "would have been obvious to one skilled in the art to modify the device taught by Fortin, by having a dampening member attached to the first and second ends (38, 39) of the first and second rod members (35, 36) as is taught by Navas[.]" *Id.* The Examiner maintains that, although Fortin is directed to rib distraction and Navas is directed to intervertebral stabilization, the references can be properly combined in an obviousness rejection because Navas's device "solve[s] the problem that Fortin poses." Applicant respectfully disagrees with and traverses these contentions. However, in an effort to expedite prosecution, Applicant has amended claim 13 above to more clearly establish that neither Fortin nor Navas, alone or in combination, discloses, teaches, or suggests all elements of claim 13.

As discussed above, claim 13, as amended, recites, "wherein the first rod member can pivot within the first damping member to adjust the alignment of the first rod member with respect to a longitudinal axis of the first damping member." Fortin and Navas fail to disclose, teach, or suggest a device "wherein [a] first rod member can pivot within [a] first damping member to adjust the alignment of the first rod member with respect to a longitudinal axis of the first damping member."

Fortin does not disclose, teach, or suggest a damping device, and Navas only discloses devices into which a rod passes in a fixed orientation parallel to the long axis of the disclosed cylinder. The Examiner asserts that "Navas discloses a device

comprising a rod member (30) having a dampening member (1)[.]” Office Action at p. 4. However, in Navas's device, no portion of rod (30) can “pivot within” cylinder 1 “to adjust the alignment of [rod (30)] with respect to a longitudinal axis of” cylinder 1. Every figure of Navas's device depicts rod 30 passing through openings (e.g., 20) with a diameter just large enough to permit rod 30 to pass through perpendicular to cover 2 and parallel to the long axis of cylinder 1. See Navas at Figs. 1, 2, and 4. Nowhere does Navas disclose, teach, or suggest a device configured such that a portion of rod 30 could “pivot within” cylinder 1 “to adjust the alignment of [rod (30)] with respect to a longitudinal axis of” cylinder 1.

Furthermore, modifying the device of Navas such that a portion of rod 30 could “pivot within” cylinder 1 “to adjust the alignment of [rod (30)] with respect to a longitudinal axis of” cylinder 1 would not have been obvious to one of ordinary skill in the art, because such a modification would be inconsistent with additional aspects of the Navas device. The Navas device is specifically designed for supporting only uniaxial translation of rod 30 and piston 3 with respect to cylinder 1. See Navas at col. 2, ll. 31-35, and Figs. 1, 2, and 4. Navas describes only embodiments configured “so as to ensure good guiding of the piston in the bore 12 of [the] cylinder 1[.]” *Id.* at col. 2, ll. 18-19. Navas explains that “good guiding” can be ensured when “the height of the piston 3 is large with respect to the length of the cylinder 1,” or in the alternative, when “rod 30 is secured to a tubular cage 7 via its bottom 70, the skirt 71 of this cage sliding closely with respect to the outside of the cylinder 1.” *Id.* at col. 2, ll. 17-18, and col. 3, ll. 28-33. These configurations necessarily prevent the piston from being able to “pivot within” the bore of the cylinder “to adjust the alignment of [rod (30)] with respect to a longitudinal

axis of" cylinder 1. Further, because the rod 30 of Navas is fixed to piston 3, rod 30 is also incapable of pivoting "to adjust the alignment of [rod (30)] with respect to a longitudinal axis of" cylinder 1. Consequently, since the device of Navas is specifically designed to prevent pivoting of piston 3 and rod 30 within cylinder 1, it would not have been obvious to modify the device of Navas to permit a portion of rod 30 to pivot within cylinder 1 "to adjust the alignment of [rod (30)] with respect to a longitudinal axis of" cylinder 1.

Therefore, for at least the reasons discussed above, Fortin and Navas, both alone and in combination, fail to disclose, teach, or suggest the device of claim 13, and the section 103(a) rejection of these claims should be withdrawn. Furthermore, claims 14-22 depend from claim 13, and thus, are not unpatentable over Fortin in view of Navas for at least the same reasons.

Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action. In discussing the claims in this Response, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification, abstract, or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 3, 2010

By:  _____

Nicholas S. Stroeher
Reg. No. 62,926
(617) 452-1647